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EXAMINER	
MARANDI, JAMES R	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/580,693	KATAOKA, MITSUTERU	
	Examiner	Art Unit	
	JAMES R. MARANDI	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 May 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/26/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following minor informalities:

   - In Paragraph [3], "Patent Document 1" and "Patent Document 2" must be clearly spelled out (Author, title, publication source, etc.).
   - In Paragraph [30], "[Patent Document 1]" and "[Non-Patent Document 2]" are not properly referenced and lead to confusion of purpose.
   - In Paragraph [38] the word "objects" appears to be a typographical error and should be changed to "Objectives".

   Appropriate correction is required.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). See MPEP 608.01(j).

   Misnumbered claim 39 has been renumbered 38.

Drawings

3. Figure 19-23 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (These Figures are all referenced as "conventional recommended program presentation device..." in the BACKGROUND ART section and the applicant has referenced them to be well known within the art). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 38 is vague as it recites a

computer recordable claim that executes the method according to claim 19 which is an apparatus claim. There are no method steps to be executed in claim 19.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, *except* that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

6. Claims 1, 2, 7, 19, 20, 25, 37, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by M.D. Ellis, USPN 7,185,355 (hereinafter "Ellis").

Regarding claims 1, 19, 37, and 38, Ellis discloses **a recommended program notification** method, process, system, and computer code **notifying a user of a recommended program** (Fig. 25; Col. 13, lines 57-61)**, comprising the steps of:**

inputting a user's instruction including a recommendation control instruction (Figs. 14, 15; Col. 11, lines 4-23)**;**

detecting notification timing with which a notification of a recommended program is performed (Fig. 15, elements 156, 158)**, when the recommendation control instruction is not input** (Col. 11, lines 21-23)**; and**

displaying a notification screen indicating the existence of a recommended program when the notification timing is detected (elements 156, 158; Figs. 25, and 26; Col. 14, lines 20-24).

Regarding claims 2 and 20, **wherein the notification timing detecting step detects timing with which a recommended program starts, as the notification timing** (Col. 11, lines 21-31).

Regarding claims 7 and 25, **further comprising displaying a list screen** (226) **indicating a list of recommended programs when the recommendation control instruction is input while the notification screen is being displayed** (Col. 13, lines 57- 61).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: ***(See MPEP Ch. 2141)***

a. Determining the scope and contents of the prior art;
b. Ascertaining the differences between the prior art and the claims in issue;
c. Resolving the level of ordinary skill in the pertinent art; and
d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

8. Claims 3, 9, 10, 11, 12, 14, 16, 17, 18, 21, 27, 28, 29, 30 , 32, 34, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of D.L. DeFreese et al., USPN 6,493,876 (hereinafter "DeFreese").

Regarding claims 3 and 21 Ellis does not disclose **wherein the notification timing detecting step detects timing with which selected stations are changed, as the notification timing.** However, in an analogous art, DeFreese substantially discloses launching an information banner upon a change in channel (Fig. 4, elements 100, 106, 114; Col. 15, lines 1-12)

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with DeFreese's teaching in order to provide additional viewing conveniences to the user.

Regarding claims 9 and 27 Ellis does not explicitly disclose **further comprising erasing the notification screen when a predetermined time has elapsed while the notification screen is being displayed.** However, Jerding substantially discloses erasing the notification (banner) 124, upon elapse of a predetermined time (e.g. 20 seconds). Fig. 4, banner turns off and/or processes between element 100 at start and elements 124, 126; Col. 15, lines 14-17.

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with DeFreese's teaching in order to provide additional viewing conveniences to the user.

Regarding claims 10 and 28 Ellis does not disclose **erasing the notification screen when an instruction other than the recommendation control instruction is input while the notification screen is being displayed.** However, DeFreese substantially discloses using various key strokes to erase the notifications (Figure 6, Col. 18, lines 50- 55).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with Defreese's teaching in order to provide additional viewing conveniences to the user.

Regarding claims 11 and 29, Ellis does not explicitly disclose **changing an information amount of a recommended program included in the notification screen when the recommendation control instruction is input**. However, DeFreese substantially discloses **changing an information amount of a recommended program** (Fig. 4, compare elements 124 and 126; Col. 15, lines 34-38) **included in the notification screen** (124, 126) **when the recommendation control instruction is input**.

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with DeFreese's teaching in order to provide additional viewing conveniences to the user.

Claims 12 and 30 are rejected by the same analysis as claims 11, and 29. Appearance and erasure of various menu/ notifications were further analyzed in claims 10, and 28.

Claims 14 and 32 are rejected by the same analysis as claims 12 and 30.

Regarding claims 16 and 34 Ellis discloses displaying "hot list" (favorites) sorted by priority (Fig. 27, element 240; Col. 14, lines 1-2) therefore presenting the recommended list based on **obtaining a recommendation reason for a program**.

However, Ellis does not disclose **including the obtained recommendation reason in the notification screen, wherein the obtained recommendation reason is in a form which can be recognized by a user**.

However, DeFreese substantially discloses **including the obtained recommendation reason in the notification screen** (Fig. 20, elements 422, 424, 432 where program theme and show times are illustrated for example)**, wherein the obtained recommendation reason is in a form which can be recognized by a user** (Col. 27, lines 38- 41; in this example the theme and show times are sorted and presented)

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with DeFreese's teaching to provide an easy program selection process for the user.

Regarding claims 17 and 35, **wherein the recommendation reason is an element selected from the group consisting of frequent viewing of a program, appearance of a specific performer in a program, belonging of a program to a specific genre, and inclusion of a specific character string in a document accompanying a program**. (Rejected as claims 16, and 34; see Ellis, Fig. 2)

Claims 18 and 36 are rejected by the same analysis as claims 17, and 35, as the iconic representation of preferences and their overlay has already been analyzed.

9. Claims 4, 5, 6, 8, 22, 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of S. M. Schein, USPN 6,732,369 (hereinafter "Schein").

Regarding claims 4 and 22, Ellis does not disclose **where the notification timing detecting step detects timing with which a channel display starts, as the notification timing**. However, Schein, in an analogous art, substantially discloses displaying a menu upon **channel display start** (Figs 17; Col. 23, lines 23-33. In Fig. 17B, by clicking the remote, the banner display of 530 is launched on the screen. Element 530 is illustrated to give the user several options which allows for launching/ selection of other options (Menu elements 0- 3). One such option is shown in Fig. 17C where the viewer sees TLC 23 while at the same time watching ABC.

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with Schein's teaching in order to provide for ease of use of program navigation and selection.

Regarding claims 5, and 23 **further comprising erasing the notification screen when the channel display is ended**, rejected as claims 4 and 22 (Fig. 17B, menu item (0)).

Claims 6 and 24 are rejected by the same analysis as claims 4, and 22.

Regarding claims 8, and 26, Ellis does not disclose **further comprising displaying a video of a recommended program when the recommendation control instruction is input while the notification screen is being displayed**.

However Schein substantially discloses **displaying a video of a recommended program** (Fig. 17C, TLC 23) **when the recommendation control instruction is input while the notification screen is being displayed** (Fig. 17C; Col 23, lines 40-42)

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis with Schein's teaching in order to provide for ease of use of program navigation and selection.

10. Claims 13, 15, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of DeFrees, in further view of A. Wagner, USPN 6,335,736 (hereinafter "Wagner").

As for claims 13 and 31, the system of Ellis and DeFreese does not disclose **wherein the notification screen is an icon which is overlaid and displayed on a program video**.
However, Wagner, in an analogous art, substantially discloses a notification Icon (Fig. 6, elements 40, 41) **is overlaid and displayed on a program video** (30).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of the invention, to modify the system of Ellis and DeFreese with Wagner's teaching in order to provide for ease of use of program navigation and selection.

Claims 15 and 33 are rejected by the same analysis as claims 13 and 31.

Prior Art Made of Record

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- J.S. Hendricks, USPN 5,798,785 substantially discloses program delivery based on analyzing, scoring, and sorting of user preferences.
- D.F. Jarding, USPN 6,463,586, discloses methods and systems for service navigation.
- P. Baudisch et al., "TV Scout: Lowering the Entry Barrier to Personalized TV Program Recommendation", Springer-Verlag, Berlin, 2003.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES R. MARANDI whose telephone number is (571)270-1843. The examiner can normally be reached on 8:00 AM- 5:00 PM M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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